REMARKS/ARGUMENTS

These Remarks are in reply to the Final Office Action mailed February 23, 2004.

Claims 1-10, 17, and 20-25 were pending in the Application prior to the outstanding Final Office Action. In the Final Office Action, the Examiner rejected Claims 1-10, 17, and 20-25. Reconsideration of the rejections is requested.

I. Specification

Although the Examiner made no objection to the specification, Applicants have amended the specification to correct a typographical error.

II. Claims Objections Under 35 U.S.C. § 103(a)

Claims 1-10, 17, and 20-25 were pending in the Application prior to the outstanding Final Office Action. In the Office Action, the Examiner rejected all the remaining claims under 35 U.S.C. § 103(a). The present Response amends claims 1, 10, and 17. Reconsideration of the rejections is requested.

A. Claims 1, 10 and 17

The Examiner rejected Claim 1 as being unpatentable under 35 U.S.C. §103(a) based on *Liming* in view of *Kaplan*. Claim 10 was rejected as being unpatentable under 35 U.S.C. §103(a) based on *Liming* in view of *Kaplan* and further in view of *Sato, Myr*, and *Takanabe*. Similarly, the Examiner rejected Claim 17 as being unpatentable under 35 U.S.C. §103(a) based on *Liming* in view of *Kaplan* and further in view of *Takanabe*. Applicant respectfully traverses each of these rejections.

Applicant has amended claims 1, 10 and 17 to formulate as distinct limitations a search area that is in part "based upon characteristics of each of the potential pathways, including but not limited to speed limit, number of turns, and potential traffic congestion." These amendments are supported by the specification (see, *e.g.,* p. 7, lines 12-27) and are intended to emphasize the feature of a search area based upon characteristics of each of the potential pathways, including but not limited to speed limit, number of turns, and potential traffic congestion, limitations that are not disclosed by *Liming, Kaplan, Sato, Myr* and *Takanabe,* considered individually or collectively.

As acknowledged by the Examiner, *Liming* does not disclose "identifying a plurality of locations in the search category with a search area which is determined based on potential pathways from an origin; computing a first travel time from an origin to a first location; storing the first travel time and respective first location." Final Office Action mailed February 23, 2004, pp. 1-2. Not only does *Liming* not disclose the above limitations, *Liming* also does not disclose the limitation of a search area that is determined "based upon characteristics of each of the potential pathways, including but not limited to speed limit, number of turns, and potential traffic congestion," as called for in amended claims 1, 10, and 17. There is no discussion in *Liming* of "a search area that is determined based upon potential pathways from an origin," much less any discussion of a search area determined based upon characteristics of each of the potential pathways, including but not limited to speed limit, number of turns, and potential traffic congestion. Finally, no teaching appears in *Liming* of "transmitting the first location and the first travel time from the remote location to the communication device," as presented in amended claims 1, 10, and 17.

The Examiner suggests that *Kaplan* teaches the capability to identify a plurality of locations in the search category in a search area that is determined based upon potential pathways. (Final

- 11 -

U.S. Application No. 09/588,096
ssvoboda/airf/1013/1013.RESPC.DOC

Office Action mailed February 23, 2004, p. 2, para. 1, citing *Kaplan,* fig. 3; fig. 10-fig. 14; col. 8, lines 15-67; col. 9, lines 1-34). The Examiner further suggests that *Kaplan* teaches computing the travel time from an origin to a first location. (Final Office Action mailed February 23, 2004, p. 2, para. 1, citing *Kaplan,* col. 7, lines 23-34; col. 9, lines 41-67; col. 10, lines 1-24). Applicant respectfully traverses these suggestions.

Kaplan, fig. 3, as discussed at col. 5, line 55-col. 6, line 49, depicts "[a] first embodiment of the navigation system feature that provides guidance for making an intermediate stop at a location (or point of interest) of a specified type..." Thus Figure 3, as cited by the Examiner is explicitly directed at an invention providing guidance for making an *intermediate* stop at a location or point of interest. Similarly, *Kaplan,* fig. 10-fig. 14, as well as the accompanying text which the Examiner also cites at col. 8, lines 15-67; col. 9, lines 1-34, presents differently shaped search areas for use in a "method and system for finding *intermediate* destinations with a navigation system [emphasis added]. There is no teaching here relating to identifying a plurality of locations in the search category in a search area that is determined based upon potential pathways. Indeed, unlike our claims, *Kaplan* teaches away from any specific method for determining a search area. Col. 5, lines 22-25.

Similarly, contrary to the Examiner's suggestion, it is respectfully submitted that there is nothing taught by *Kaplan* regarding computing the travel time from an origin to a first location. The first section of *Kaplan* cited by the Examiner in this regard is col. 7, lines 23-34, which teaches a menu displaying a plurality of *categories* from which the user can choose one. This passage discussing a graphical user interface facilitating operation of the invention in *Kaplan* contains no mention whatsoever of computing a travel time from an origin to a first location. Similarly, contrary to the Examiner's suggestion, *Kaplan* (col. 9, lines 41-67; col. 10, lines 1-24) does not teach

- 12 -

computing the travel time from an origin to a first location. Rather, this section of *Kaplan* teaches

that a user specifies a type of point of interest at which the user wishes to make an intermediate stop

while on route to a final destination. The feature identifies for the user one point of interest of the

specified type wherein the total travel time including the intermediate stop takes less time than if an

intermediate stop were made at another point of the specified type. No reference appears in this or

any section of *Kaplan* to computing a travel time from an origin to a first location. Unlike the current

claims, *Kaplan* does not specify the method for determining a search area and in fact explicitly

disclaims any specific calculation method. (Col. 5, lines 22-25). *Kaplan* teaches that "the subject

matter claimed herein is not limited to any particular method of route calculation. Any suitable route

calculation method now known or developed in the future may be employed." (col. 5, lines 22-25).

By contrast, the present application discloses a specific approach to determining a search

area, according to which a search area determined based upon potential pathways from an origin and

based upon characteristics of each of the potential pathways, including but not limited to speed limit,

number of turns, and potential traffic congestion. Computing information for destinations within a

search area defined by potential pathways from an origin and based upon characteristics of each of

the potential pathways, including but not limited to speed limit, number of turns, and potential traffic

congestion not only decreases processing time by potentially reducing the number of destinations, it

may also identify a destination that is physically farther away than another but quicker and/or easier

to get to because it is on a main pathway (e.g. a highway) and thus within the search area determined

by potential pathways.

Kaplan simply does not disclose these claimed limitations and in fact teaches away from

specific approaches to route calculation, disclosing that "the subject matter claimed herein is not

- 13 -

limited to any particular method of route calculation. Any suitable route calculation method now known or developed in the future may be employed." (col. 5, lines 22-25).

Like *Liming, Kaplan* also fails to disclose the limitation of determining a search area "based upon characteristics of each of the potential pathways, including but not limited to speed limit, number of turns, and potential traffic congestion," as called for in claims 1, 10, and 17. By contrast, *Kaplan* instead discloses a method and system for finding *intermediate* destinations with a navigation system. Referring to Figure 3 of *Kaplan, Kaplan* discloses that, assuming the intermediate stop routine 102 found three points of interest of the type specified by the user in the search area, POI(1) being designated as the point of interest located closest to the path of the solution route, POI(2) being located next closest, and POI(3) being located farthest from the path of the solution route, nevertheless, it may take less time to make a detour past POI(3) than either POI(1) or POI(2). *Kaplan* discloses that by comparison with POI(3), which is accessible by controlled access roads with relatively high speed limits, POI(1) is at a location which is accessible by a series of lower ranked roads. (*Kaplan,* col. 9, lines 55-67; col. 10, lines 1-24.) As with *Liming,* there is no discussion in *Kaplan* of a search area, nor of a method wherein the search area is determined based upon potential pathways from an origin, nor of a method wherein the search area is determined based upon characteristics of each of the potential pathways, including but not limited to speed limit, number of turns, and potential traffic congestion, as called for in Claims 1, 10, and 17.

Sato also fails to disclose the limitations of a method "wherein the search area is determined based upon potential pathways from an origin, and based upon characteristics of each of the potential pathways, including but not limited to speed limit, number of turns, and potential traffic congestion" as called for in Claims 1, 10, and 17. The Examiner notes that Sato teaches expanding the search

area (Final Office Action mailed February 23, 2004, p. 2, para. 3, citing *Sato,* col. 5, lines 13-15). *Sato* discloses a system for providing vehicle navigation to a destination in a category along a suitable route. As indicated by the Examiner, and as illustrated in Figure 2 of *Sato,* the system of *Sato* searches for a category, such as a convenience store, within a "search area." *See, Sato* Fig. 2. In particular, the "search area" as described in *Sato* "is selected from a 'large area' for search within a 10 km radius from the current vehicle position, a 'normal area' for search within a 5 km radius from the current vehicle position and a 'small area' for search within a 1 km radius from the current vehicle position." *Sato,* col. 5, lines 26-30; Fig. 2. Thus, the search area utilized in *Sato* is based upon a distance from the current vehicle position and is <u>not</u> "determined based upon potential pathways from an origin, and based upon characteristics of each of the potential pathways, including but not limited to speed limit, number of turns, and potential traffic congestion," as called for in independent Claims 1, 10, and 17.

Defining a search area based upon potential pathways provides a defined search area that may include destinations that would not be included in a simple radius area because they are near a potential pathway. Referring to Fig. 4 of the present Application, search area 162 is not a simple circle centered around current location 100 but rather has peaks 166 and 167 because a user can more rapidly access areas within those peaks due to the characteristics of each of the potential pathways, including but not limited to speed limit, number of turns, and potential traffic congestion. *Sato* does not disclose search areas that are defined based upon potential pathways from an origin, and based upon characteristics of each of the potential pathways, including but not limited to speed limit, number of turns, and potential traffic congestion. Thus *Sato* also fails to disclose the limitations of claims 1, 10, and 17.

- 15 -

Finally, *Takanabe*, which is cited in combination with *Liming* and *Kaplan* as a basis to reject independent claim 17, describes a vehicle navigation system that, as stated by the Examiner, sorts destinations in ascending time order (Final Office Action, p. 4, para. 1, citing *Takanabe*, col. 6, lines 1-13). Like *Liming* and *Kaplan*, *Takanabe* fails to disclose the limitations of a method "wherein the search area is determined based upon potential pathways from an origin, and based upon characteristics of each of the potential pathways, including but not limited to speed limit, number of turns, and potential traffic congestion" for in independent claim 17. Thus, since *Liming, Kaplan, Sato,* and *Takanabe* do not disclose all of the limitations of independent Claims 1, 10, and 17, either singly or in combination, any combination of those references cannot render Claim 1, 10, and/or 17 obvious.

Accordingly, Claims 1, 10, and 17, as amended, are believed patentable under 35 U.S.C. §103(a) over *Liming, Kaplan, Sato, Myr* and *Takanabe*, and the withdrawal of the Examiner's rejection of Claims 1, 10, and 17 based on 35 U.S.C. §103(a) is requested.

B. Claim 5

Claim 5 was also rejected by the Examiner as unpatentable over *Liming* in view of *Kaplan* and further in view of *Sato*. Applicants respectfully traverse the rejection. The Examiner suggests that *Sato* (the Examiner cites col. 5, lines 13-15) discloses claim 5's limitation of a method further comprising the step of expanding the search area. Applicants respectfully traverse this suggestion and respectfully note that the Examiner's cited excerpt does not disclose this limitation of claim 5. The cited section of *Sato* presents a set of alternative *categories* from which a search destination category may be selected. The exemplary categories listed are "convenience stores, banks, motor vehicle dealers, public restrooms, supermarkets, department stores, game centers, pinball parlors,

- 16 -

beaches, skiing areas, railroad stations, hotels, family restaurants, Japanese-style restaurants, etc."

(col. 5, lines 12-15). The art here disclosed by *Sato* relating to alternative choices for the *category* of

the *destination* says nothing about the very different limitation of expanding the (geographical) *size*

of the search *area* and thus does not disclose these limitations of claim 5. Therefore, Applicant

respectfully traverses the Examiner's suggestion, "It would have been obvious to a person of

ordinary skill in the art at the time the invention was made to expand the search area of the combined

teaching of Liming and Kaplan in order to provide the user a destination suggestion that is further the

limited search area." (Final Office Action mailed February 23, 2004, p. 2, last para.) Accordingly,

claim 5 is believed patentable under 35 U.S.C. § 103(a) over *Liming* in view of *Kaplan* and further in

view of *Sato* and withdrawal of the Examiner's rejection is requested.

C.   Claims 2-9 and 20-25

The references cited in the Final Office Action, in particular *Liming, Kaplan, Sato, Myr* and

Takanabe, fail to disclose all of the limitations of amended Claims 1, 10, and 17, either singly or in

combination. Claims 2-9 and 20-25 each ultimately depend from independent claims 1 and 17,

respectively, and should therefore be patentable for at least the same reasons as independent Claims

1 and 17. It is submitted that these claims also add their own limitations that render them patentable

in their own right. Accordingly, dependent Claims 2-9 and 20-25 are believed patentable under 35

U.S.C. §103(a), and withdrawal of the Examiner's rejection is requested.

Accordingly, Claims 1-10, 17, and 20-25 are believed patentable under 35 U.S.C. § 103(a)

over the cited references and withdrawal of the rejections is respectfully requested.

- 17 -

III. Statement of Eligibility for Small Entity Status

Pursuant to 37 C.F.R. 1.27 (c)(1), applicant declares that it is eligible for small entity status and accordingly submits an appropriate small entity fee for the present application.

IV. Conclusion

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.
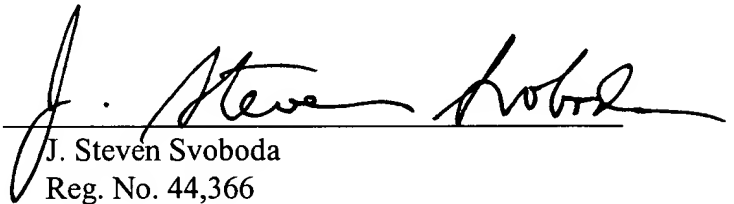
The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: 8/16/0P

By: _____
J. Steven Svoboda
Reg. No. 44,366

FLIESLER MEYER LLP
Four Embarcadero Center, Fourth Floor
San Francisco, California 94111-4156
Telephone: (415) 362-3800

- 18 -